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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,401

07/15/2004

Hisanori Kachi

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2796

23117 7590 01/15/2009  
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EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

01/15/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,401	<b>Applicant(s)</b> KACHI ET AL.	
	<b>Examiner</b> ERIC E. SILVERMAN	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-20-08</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/20/2008 has been entered. Claims 20-27 are pending.

### ***Information Disclosure Statement***

The references lined through on the information disclosure statement were not considered because they are not in English.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10575260 in view of EP 1044672 ("672").

Although the conflicting claims are not identical, they are not patentably distinct from each other because the amounts of materials required by the copending claims are different from those of instant claims, but overlapping therewith. Also, while claim 1 of the copending application does not require the ester compound of claim 27, copending claim 4 teaches this compound. Furthermore, the copending application does not teach the use of inorganic salts. 672 teaches that inorganic salts, such as sodium chloride and others, stabilize cosmetic W/O emulsions. It would thus have been obvious to add inorganic salts to the composition of '260, thereby reaching the claimed composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,362,482 to Yoneyama ("Yoneyama") in view of JP 10-273433 ("433") and EP 1044672 ("672").

Yoneyama teaches W/O cosmetic compositions containing an oil component by 5 to 85% by weight. Col. 3. The oil may be an ester oil, such as glycerol tri-2-ethylhexanoate or pentaerythritol tetra-2-ethylhexanoate. Col. 5. Other oils, such as silicone oil (oil other than ester oil) are also included. Abstract.

What is lacking is the ester of instant claims, sunscreen agents, other excipients, and inorganic salts.

The 433 reference teaches W/O. These compositions having an ester compound made from the esterification of glycerin, behenic acid, and eicosan dicarboxylic acid, as required by instant claims 1 and 6 (table 2, paragraph 0016). The compositions are oil-in-water emulsions (paragraph 0010), and are used as sunscreens (paragraphs 0007 and 0008, describing the compositions as having "ultraviolet ray absorbent is offered"). The ratio of the glyceryl, behenic acid, and eicosane diacid is commensurate with that required by instant claims (paragraph 0025). The formulation, as expounded in table 2 (see USPTO translation of this table), includes octyl methoxycinnamate (sunscreen agent), liquid paraffin and squalane (oils other than ester oil) and PEG 6000 (a surfactant). Other excipients, such as stearates and dibutylene glycol are included. The ratio of ester compound and ester oil is commensurate with instant claims.

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The 672 reference teaches oil-in-water cosmetics for application to skin or hair (paragraph 0002). Inorganic salts or amino acids are added to impart stability to W/O emulsion (abstract). The inorganic salts are chosen from those listed in claim 5, for example, sodium chloride, potassium chloride, aluminum sulfate, etc.

It would have been prima facie obvious to a person of ordinary skill in the art at to add the glyceryl behenate/eicosanate and inorganic salts to the W/O compositions of Yoneyama. Glyceryl behenate/eicosanate appears to be a conventional ingredient in W/O cosmetics. The use of a material for its art intended purpose is obvious, absent secondary considerations. It would have been prima facie obvious to a person of ordinary skill in the art at the time of the invention to add inorganic salts, as taught by 672, in order to achieve the recognized advantage of these ingredients, namely increased emulsion stability.

### ***Response to Arguments***

Applicants' arguments addressed rejections over claims that are currently cancelled. The only argument that appears to be germane to the rejection pending is the argument that the artisan would not expect to be able to use ester oils in a W/O emulsion in the indicated amounts. This is not persuasive because the Yoneyama reference teaches the use of oils, including ester oils, in the recited amounts.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC E. SILVERMAN whose telephone number is (571)272-5549. The examiner can normally be reached on Monday to Thursday 7:00 am to 5:00 pm and Friday 7:00 am to noon.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571 272 0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/  
Examiner, Art Unit 1618